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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,162	03/06/2002	Sherrene D. Kevan	GOW 0091 PA	9230

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04/21/2005

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EXAMINER

ORTIZ, BELIX M

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,162

Applicant(s)

KEVAN ET AL.

Examiner

Belix M. Ortiz

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

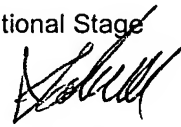
Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications files on 10-January-2005, claim 13 was added and the specification of the disclosure per applicant's request. Therefore, claims 1-13 are presently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Levitt (U.S. publication 2002/0151327).

As to claim 1, Levitt teaches a system for provisioning electronic field guides (see page 1, paragraph 2) comprising:

a portable computing device having (see page 1, paragraph 2);

a visual display (see abstract; figure 4D; page 3, paragraph 20; and page 4, paragraph 30);

an end user input interface (see abstract; page 1, paragraph 5; and page 3, paragraph 20);

and

a memory (see page 16, paragraph 290);

a stationary computer (see page 2, paragraph 11) having:

a visual display (see page 3, paragraph 18);

an end user input interface (see figure 1a “desktop setup interface”); and

a memory (see page 2, paragraph 11);

means for interconnecting the stationary computer and the portable computing device

(see page 2, paragraphs 11 and 13 and page 3, paragraph 318);

the stationary computer (see page 2, paragraph 11) being operable to:

present multiple data items to an end user (see abstract and page 3, paragraph 18 and 20); and

respond to the selection of particular ones of the multiple data items by the end user (see page 1, paragraph 7 and page 3, paragraph 24), by:

downloading multimedia data files corresponding to the particular ones of the multiple data items, to the portable computing device via the means for interconnecting (see page 2, paragraph 11; page 4, paragraph 26; and page 6, paragraph 73); and

the portable computing device (see page 1, paragraph 2) being operable to:

present a listing of the downloaded multiple data items (see page 3, paragraph 20); and

respond to the selection of one of the downloaded multiple data items by playing the corresponding multimedia data file (see page 3, paragraph 20 and page 7, paragraph 86).

As to claim 2, Levitt teaches a method for provisioning electronic field guides (see page 1, paragraph 2) comprising the steps of:

presenting multiple data items to an end user, via the display of a stationary computer (see abstract; page 2, paragraph 11; and page 3, paragraphs 18 and 20); and

responding to the selection of particular ones of the multiple data items by the user (see page 1, paragraph 7 and page 3, paragraph 24), by:

downloading multimedia data files corresponding to the particular ones of the multiple data items, to a portable computing device (see page 2, paragraph 11; page 4, paragraph 26; and page 6, paragraph 73);

whereby the portable computing device may present the multimedia content to the end user in the field (see page 3, paragraph 20).

As to claim 3, Levitt teaches the method which the multimedia content includes images and text, whereby images can be viewed on the portable computing device (see figure 4D and page 14, paragraph 263).

As to claim 4, Levitt teaches the method which the multimedia content includes audio files, whereby sounds may be reproduced on the portable computing device (see abstract and page 3, paragraph 22).

As to claim 5, Levitt teaches the method which the stationary computer is a personal computer (see page 2, paragraph 11).

As to claim 6, Levitt teaches the method which the stationary computer is an information kiosk providing the content in exchange for some form of payment (see page 7, paragraph 96).

As to claim 7, Levitt teaches the method which the multimedia data files are stored on a CD-rom (see page 3, paragraph 22; page 5, paragraph 69; and page 16, paragraph 293).

As to claim 8, Levitt teaches the method which updates to the multimedia data files are accessed over an Internet network (see figure 1a, character 26 and page 2, paragraph 10).

As to claim 9, Levitt teaches the method which the multimedia data files are stored remotely from the stationary computer and are accessed over an Internet network (see figure 1a and page 2, paragraph 11).

As to claim 10, Levitt teaches a portable electronic field guide (see page 1, paragraph 2) comprising:

display means for displaying a digital image (see abstract “handheld personal digital assistant” and page 4, paragraph 26);

speaker means for audibly reproducing a digital audio data file (see abstract and page 3, paragraph 22);

memory means for storing digital content to produce the digital image and the digital audio data (see page 2, paragraph 11 and page 16, paragraph 290);

communication means for downloading the digital content from a stationary computer (see page 2, paragraph 11), the digital content being selected from a more comprehensive database on the stationary computer (see page 2, paragraph 11); and

power supply means for powering the display means, speaker means, memory means and communication means (see figure 4D, character 154 and page 4, paragraph 42).

As to claim 11, Levitt teaches the portable electronic field guide (see page 1, paragraph 2) further comprising:

processing means responsive to an instruction from an end user (see page 9, paragraph 139) by:

accessing the digital content stored in the memory means (see abstract and page 7, paragraph 87); and

displaying the digital image corresponding to the digital content, on the display means (see page 3, paragraph 20; page 5, paragraph 69; and page 7, paragraph 86).

As to claim 12, Levitt teaches the portable electronic field guide (see page 1, paragraph 2) further comprising:

processing means responsive to an instruction from an end user (see page 9, paragraph 139) by:

accessing the digital content stored in the memory means (see abstract and page 7, paragraph 87); and

playing the digital audio data corresponding to the digital content, on the display means (see page 3, paragraph 20; page 5, paragraph 69; and page 7, paragraph 86).

As to claim 13, Levitt teaches a portable electronic field guide for bird watching (see paragraph 2), comprising:

a visual display configured to display a digital image of a bird (see abstract “handheld personal digital assistant” and page 4, paragraph 26);

a speaker for audible reproducing a digital audio data file of a bird (see abstract and page 3, paragraph 22);

a memory configured to store digital content to produce the digital image and the digital audio data (see page 2, paragraph 11 and page 16, paragraph 290);

a communication device configured to download the digital content from a stationary computer, the digital content being selected from a more comprehensive database on the stationary computer (see page 2, paragraph 11); and

power supply means for powering the display, speaker, memory, and communication

device (see figure 4D, character 154 and page 4, paragraph 42).

Response to Arguments

4. Applicant's arguments filed 10- January- 2005 with respect to the rejected claims in view of the cited references have been fully considered but they are not found persuasive:

In response to the affidavit submitted under 37 CFR 1.131 has been considered, but id not effective in establishing a prior conception and diligence leading reduction to practice for the following reasons:

- 1). The affidavit does not establish conception of the claimed invention prior to the priority date of the Levitt reference. At most, the affidavit documents only establish conception of a CD containing bird songs, but not the claimed invention.

- 2). The affidavit does not establish diligence towards reduction to practice by filing a provisional or non-provisional patent application. There are also no dates associated with any activities of diligence.

In response to applicants' arguments that the provision must be utilized as the prior art reference in the rejection if its priority date is relied upon. However, the MPEP contains no such requirement. MPEP 2136.03, Section III clearly indicates that the Levitt reference as a pre-grant publication may be relied upon and its earliest priority date may be relied upon as an effective date.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 571-272-4081.

The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

bmo

March 31, 2005



**SAM RIMELL
PRIMARY EXAMINER**